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| VERDIER, CHRISTOPHER M | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/677,870
Filing Date: October 03, 2003
Appellant(s): IKETANI, MASAMICHI

Jeffrey D. Sanok
Richard R. Diefendorf
For Appellant

## EXAMINER'S ANSWER

This is in response to the appeal brief filed April 28, 2006 appealing from the Office action mailed June 14, 2005.

### (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

### (2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### (3) Status of Claims

The statement of the status of claims contained in the brief is correct.

### (4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

### (5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

### (6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

### (7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

### (8) Evidence Relied Upon

| | | |
|---|---|---|
| H09-021,396 | Japan | 1-1997 |
| 6,682,076 | Hosoda et al. | 1-2004 |
| 5,056,799 | Takenaka et al. | 10-1991 |
| 4,155,560 | Repella | 5-1979 |
| 2003/0189293 | Johnen | 10-2003 |
| H10-331,985 | Japan | 12-1998 |

### (9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 9-21,396 in view of Hosoda 6,682,076 and either (Takenaka 5,056,799 or Repella 4,155,560 or Johnen 2003/0189293) and Japanese Patent 10-331,985. This rejection is set forth in the Office action mailed June 14, 2005.

### (10) Response to Argument

Appellants have argued that Takenaka, Repella, and Johnen do not disclose the claim limitation that the amount of elastic deformation of the second seal lip is at least 1/10 and up to 7/10 of the height of the second seal lip in a free state, because the text of these references does not disclose the claimed percentage of deformation, and that it is apparent that the conclusions as to what these references teach is based solely on measuring the drawing features. Appellants have argued that the text of each reference does not disclose that the drawings are to scale and are silent as to dimensions. Appellants have cited MPEP 2125, under its second subheading, arguing that this addresses the specific issue of whether proportions of features in a drawing are evidence of actual proportions when drawings are not to scale. Appellants have argued that here the MPEP states that "arguments based on measurement of drawing features are of little value if the reference does not disclose that the drawings are to scale and is silent as to dimensions", and cite *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000), as well as *Nystrom v. TREX Co.*, 339 F.3d 1347 67 USPQ2d 1858 (Fed. Cir. 2003), and refer to footnote 5, which states that "arguments based on drawings not explicitly made to scale in issued patents are unavailing". Appellants have further argued that the MPEP establishes that although as a general proposition drawings can be used as prior art, measurement of drawing features are of little value if the reference does not disclose that the drawings are to scale and is silent as to dimensions, that no exceptions to this rule are provided in the MPEP, and that in the present application, the deformation percentages cannot be obtained by measuring the drawing features of the cited references, because the references do not disclose that the drawings are to scale and are silent as to dimensions.

Appellants have further argued that the examiner has ignored the above second subheading of MPEP 2125, and instead focuses on the first subheading, which states that drawings can be used as prior art, and ignores the second subheading which states that "proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale. Appellants have further argued that the examiner's position that each of Takenaka, Repella, and Johnen show both deformed and free states in a single figure and would not show a different scale in moving from one position to another position in a single figure is incorrect, because a figure is to scale if the relative sizes of the components shown in the figure are the same as those in an actual embodiment. Appellants have further argued that there is no disclosure in either Takenaka, Repella, or Johnen that this is the case, and that there is no disclosure that the size of a seal lip in a free state relative to the elastic deformation of the seal lip in the figure is the same as that in an actual embodiment.

The above arguments are not agreed with, because MPEP 2125 states that "Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz* 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). However, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928)". Therefore, based on the above case law, the drawings and pictures can logically be said to render obvious the claims. As further set forth in *In re Mraz*, it is stated that "Although patent drawings are not working drawings, this does not mean that things clearly shown in drawings of the reference patent are to be disregarded in determining patentability of claims." MPEP 2125 further sets forth that "The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanain*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979)."

MPEP 2125 states that "However, the description of the article pictured can be relied upon, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977)." One of ordinary skill in the art would recognized that figures 1-4 of Takenaka, figure 2 of Repella, and figure 5 of Johnen reasonably disclose and suggest that the dotted/phantom positions of the seals show the amount of elastic deformation of the lip, which occurs when the tip edge of the seal lip comes in contact with the outer peripheral surface of the cylindrical rotating shaft, is at least 1/10 and up to 7/10 the height of the seal lip in a free state, as set forth below. Takenaka '799 (column 3, lines 1-7) states that the auxiliary lip portion 5a of the seal 5 extends obliquely forwardly from the end portion toward the rotary shaft 2 under a free condition before the lip end 5a comes into contact with the surface of the outer end portion of the lip 6 as indicated by a phantom line in figure 1, and that the auxiliary lip portion 5a is biased in a direction in which an inner circumferential portion of the lip 6 is brought into contact with the rotary shaft 2 under the assembled condition. Similar arguments pertain to the embodiment of figures 3-4. Repella '560 (column 3, lines 5-13) states that the annular extension shown in figure 2 is shown in phantom lines in its as molded configuration, and that when the lip seal is installed, an interference fit is provided with the secondary lip 57 and the auxiliary lip 59 being biased into contact with the shaft 34. Johnen (paragraph 24 and paragraph 43) states that the shaft sealing ring has sealing lip 1 shown as mounted to the shaft 3 (in thick lines) and shown in thin lines as manufactured, and that positions I and I' are the extremes. Therefore, as set forth in MPEP 2125 and *In re Wright*, the description of the article pictured can be relied upon, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. Because Takenaka, Repella, and Johnen clearly show the structure which is claimed, as set forth in *In re Mraz*, and because the pictures show all the claimed structural features and how they are put together, as set forth in *Jockmus v. Leviton*, it is respectfully submitted that Takenaka, Repella, and Johnen may be relied upon to teach the claimed seal lip deformation percentages.

Additionally, each of Takenaka, Repella, and Johnen clearly show both the elastically deformed state and the free state in the same single respective drawing figure, and would not show a different scale in moving from one position to another position in the same single respective figure. It is respectfully submitted that the question of whether or not the drawings of Takenaka, Repella, and Johnen are to scale is a moot point, in view of the fact that each of these references clearly shows both the elastically deformed state and the free state in a single figure via the use of dotted/phantom lines. As set forth throughout the prosecution history by the examiner, the claimed range of the elastic deformation of the second seal lip being at least 1/10 and up to 7/10 of the height of the second seal lip in a free state is of such a wide and broad range of values that Takenaka, Repella, and Johnen can reasonably be said to disclose this range as measured from the drawings, even if the exact values of the range are not specifically described in the specifications thereof.

## (11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Christopher Verdier

Primary Examiner

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